

## **REMARKS/ARGUMENTS**

Applicant has amended independent claims 18, and 26 and dependant claims 24, 25, and 28, and respectfully states that all claims are in condition for allowance.

### **Election/Restriction**

Reconsideration of the Restriction Requirement of November 21, 2005 is requested in the following limited way with respect to claim groups I and III. Applicant requests that the Office combine claims groups I (method of making apparatus) and group III (apparatus) into one group and examine these two claim groups together because the Office has not shown separate utility nor that there is a serious burden presented to the Office. On the contrary Applicant is a small entity and the cost of prosecuting multiple patent applications before the Office is onerous and thereby prevents Applicant from receiving a proper examination for his invention.

### **Traverse**

Applicant respectfully traverses the restriction of the instant applicant into groups I and III and requests reconsideration of the restriction requirement in light of the following remarks.

In the Office Action dated 11/21/05, the Office stated that:

"Inventions I through V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are **distinct** (emphasis added) from each other if they are shown to be separately usable. In the instant case, inventions I through V have separate utility such as the independent details of the apparatus may be separately usable and the

manner of operating the apparatus does not specifically need to be provided by the method of configuring and arranging the apparatus.

Because these inventions are **distinct** (emphasis added) for the reasons given above and the search required for individual inventions of Group I-V is not required for the remainder, restriction for examination purposes as indicated is proper. Although the listed classifications are the same, there is still a burdensome search as the subcombination and methods are not specifically limited to be only usable with all other subcombinations.” Office Action, 11/21/05, page 2-3.

Respectfully, Applicant contends that:

1. the Office has not shown “separate utility” as required by MPEP 806.05(d) in order to support the assertion that the subcombinations are distinct; and
2. even if the Office demonstrates “separate utility,” the Office has failed to explain why there would be a “serious burden” on the Office if restriction is not required, such explanation is required of the Office by MPEP 808.02 in order to support restriction.

Respectfully, the Office has not made out a proper *prima facie* case for restricting the claims in the instant application. Specifically, to establish a *prima facie* case for restriction the Office needs to:

- (1) provide reasons why the inventions as claimed are distinct, and
- (2) MPEP 808.02 – establish the burden on the Office by explaining why the distinct inventions must be restricted on the basis of:
  - (a) separate classification;
  - (b) separate status in the art, or

(c) a different field of search.

### **Lack of Distinctness Between Subcombinations**

Applicant maintains that the subcombinations are not distinct since they are usable together (subcombinations overlap in scope). MPEP 806.05(d), page 800-45, column 2, paragraph 5. "If they are not distinct, restriction is never proper." MPEP 806.05, page 800-44, column 1, paragraph 1.

Respectfully, Applicant points out that the Office has failed to show how the subcombinations are separately usable. According to MPEP 806.05(d):

"Two or more claimed subcombinations disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually restrictable when the subcombinations do not overlap in scope and are not obvious variants." MPEP 806.05(d), page 800-45, column 2, paragraph 5.

MPEP 806.05(d) requires the Office to specifically identify the appropriate group number or to identify the subcombination (see Examiner Note 2, page 800-46) and then to suggest utility other than with the other subcombination(s) (see Examiner Note 3, page 800-46).

"The Examiner must show by way of example, that one of the subcombinations has utility other than in the disclosed combination." MPEP 806.05(d), page 800-46, column 1, paragraph 3.

Respectfully, in the instant application, the Office has not fulfilled the requirements necessary to support restriction. Specifically, the Office has not indicated how the method of making (group I) has separate utility from the apparatus claims (group III). No example of separate utility apart from the disclosed combination, found in the application, has been proffered by the Office as is required by MPEP 806.05(d) page 800-46, column 1, paragraph 3.

Respectfully, Applicant contends that restriction in the instant application is improper since the Office has failed to demonstrate that the asserted subcombinations are distinct. The Office has failed to provide the required specific examples of "utility other than in the disclosed combination." MPEP 806.05(d) page 800-46, column 1, paragraph 3.

#### **Lack of Serious Burden on the Office**

Applicant maintains that the subcombinations, as defined by the Office, are related and not distinct, therefore restriction under 35 U.S.C. 121 is never proper. MPEP 808.02, page 800-51, column 2, paragraph 5. Respectfully, Applicant maintains that the Office has failed to carry its burden under MPEP 808.02, which requires the Office to demonstrate that a serious burden is presented if the restriction is not made.

In the instant case, all subcombinations are in the **same** classification. Therefore MPEP 808.02 (A) is not grounds to support restriction.

The office has not shown that the asserted subcombinations have achieved separate status in the art. In order to show separate status in the art, the Office can cite patents to demonstrate recognition of separate inventive effort by inventors or that a separate field of search is required. MPEP 808.02(B). Therefore MPEP 808.02 (B) is not grounds to support restriction.

Respectfully, the Office has merely stated that "there is still a burdensome search" even though the asserted subcombinations have the same classification. The office has not demonstrated that a different field of search is required. On the contrary, Applicant points out that the similar terms or functional limitations found in claims presented in groups I and III simplify the requirements of search. Therefore MPEP 808.02 (C) is not grounds to support restriction.

#### **Requirement of Restriction is Discretionary for the Office**

Applicant wishes to point out that MPEP 803 uses permissive language with regard to restriction, i.e.:

"If the search and examination of all the claims in an application can be made without **serious** burden (emphasis added), the examiner must examine them on the merits, even though they include claims to independent or distinct inventions." MPEP 803, page 800-4, column 1, paragraph 2.

In the instant case, the present restriction places a large financial burden on the Applicant since four divisional patent applications would be required to accomplish examination of all 43 claims. Applicant is a small entity with finite resources and respectfully states that the

instant restriction requirement jeopardizes Applicant's ability to obtain a proper examination of the instant patent application.

The additional divisional patent applications that could result from the instant restriction will exacerbate the already large workload at the Office, lengthening the time required to complete examination of the potential multiple patent applications. Applicant contends that this result does not further either the interests of the Applicant, the Office, or the public.

### **35 USC 112**

The Office rejected claims 24, 25, 28, 29, 50, and 51 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Wherein the Office stated:

"These claims relate to a vehicle model and are inherently unclear. The transmission and vehicle structure is all that is relevant in a patent claim not the name of the particular vehicle that includes a transmission. More specifically, the transmissions in these models may not be the same from year to year, may have optional transmissions, or the vehicles model may be discontinued in the future, therefore, the claim is unclear"

(Office Action, page 3-4).

In one or more embodiments, Applicant has presented claims to an improvement in an all terrain vehicle transmission(s) and has endeavored to claim such with different all terrain vehicle's make and model numbers. However, the Office has maintained that specifying



the transmission as such is indefinite. Applicant has submitted new figures 14A through 22 D to clearly illustrate the existing transmissions to which embodiments of the invention can be applied. Note from these figures, that contrary to the Office's assertions there are not different transmission in a given model year and in fact the transmission is specified by the "make" and "model" numbers for a particular all terrain vehicle. In light of the foregoing, Applicant maintains that the currently pending claims are not indefinite and that the 35 USC 112 rejection should be removed.

### **35 USC 103(a)**

The Office has rejected claims 18, 19 and 24-29 under 35 U.S.C. 103(a) as being unpatentable over Pestotnik (Pestotnik), USPN 6,182,784 (provided in Applicant's IDS) in view of Hasegawa et al. (Hasegawa) USPN 2003/0070848 and further in view of Grayson (Grayson), USPN 5,247,845. The Office has rejected under 35 U.S. C. 103(a) claims 21-23 and 49-51 as being unpatentable over Pestotnik in view of Hasegawa and Grayson as applied to claims 18, 19, and 24-29 above, and in further view of Yokoyama (USPN 5,144,852) (Yokoyama).

Applicant respectfully points out that according to the MPEP §2142, "to establish a *prima facie* case of obviousness, three basic criteria must be met:

- 1<sup>st</sup> there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings;
- 2<sup>nd</sup> there must be a reasonable expectation of success;

- 3<sup>rd</sup> the prior art reference (or references when combined) must teach or suggest all of the claim limitations.”

These criteria have not been met and Applicant's pending claims overcome the combination of Pestotnik, in view of Hasegawa, in view of Grayson and in further view of Yokoyama.

Respectfully, the Office uses hindsight reasoning to combine the cited references and then assert that Applicant's invention results therefrom. None of the references cited by the Office, either singly or in combination, teach how to modify an existing all terrain vehicle (ATV) transmission as shown in **Figure 14A** through **Figure 22D** to provide a first neutral position and then a second neutral position in order to facilitate creation of a power take-off where one did not previously exist as Applicant does in Applicant's claims. Applicant's invention permits the modified ATV transmission to operate as a power takeoff, wherein the transmission shaft delivers power to the power takeoff point, while depriving power from the ATV's wheels.

Hasegawa's farm tractor and associated drive train do not meet the limitations of Applicant's modified all terrain vehicle transmission as recited in Applicant's claims; there is no teaching in Hasegawa to suggest in any way Applicant's claim limitations. Hasegawa's working vehicle is a large tractor that separates a main-speed-change unit from a sub-speed-change unit, as shown in Hasegawa's Figure 13 and discussed as follows:



"Also, the arrangement with the main-speed-change-unit, which vibrates relative to the sub-speed-change unit, being disposed independently of the sub-speed-change unit with a distance therefrom results in creation of a free space between the main- and sub-speed-change units.

Hasegawa ¶ [0014]

In one or more embodiments, Applicant's invention uses the all terrain vehicle's transmission shaft as the power takeoff shaft; there are no extra units, extra parts, and extra shaft as required by Hasegawa's teaching.

Similarly, Pestotnik discloses a continuously variable transmission (CVT) which is not Applicant's transmission. Neither does Pestotnik suggest or teach how to modify an all terrain vehicle transmission in order to create a power takeoff unit where one did not formerly exist. Neither Pestotnik nor Hasegawa suggest nor teach how to modify an all terrain vehicle's transmission shaft and shift mechanism to enable the transmission shaft to perform the dual use of transmission shaft and power takeoff shaft as Applicant teaches. Pestotnik's power takeoff shaft 56a is not the transmission shaft.

Hasegawa's farm tractor is much larger than Applicant's ATV and presents a fundamentally different mechanical design and solves a vibration problem presented by that fundamentally different mechanical design. There is no suggestion to combine these references nor is there any indication of success that Pestotnik's CVT transmission could be replaced with a non-belt type transmission complete with power takeoff where the transmission shaft function as the power takeoff shaft .

Yokoyama merely shows a shift plate and nothing more. There is no teaching in Yokoyama that explains how to provide neutral positions in existing transmissions where such neutral positions did not previously exist. There is no indication of whether or not this could even be done at all successfully. To assert, as the Office has done, that Yokoyama could teach this detail is impermissible hindsight reasoning.

Grayson teaches an adaptation to a "crankshaft 12." Grayson Col. 3, lines, 17, 27, 35, 44; Col. 4, lines, 1, 7, 8, 17, 23, 26. Grayson does not teach adaptation to a transmission shaft. A crankshaft is not a transmission shaft. Transferring power from Grayson's crankshaft extension will not make Applicant's invention.

The combination of cited art, either singly or in combination, does not teach or suggest all of Applicant's claim limitations. There is no suggestion in the art to combine the references as the Office has done. There is no expectation of success in achieving Applicant's claim limitations by making the combination of references.

**CONCLUSION**

Applicant has cancelled claims 1-17, 25, 30-43, 46, and 50-51. Applicant has amended claims 18, 21, 22, 23, 24, 26, 28, 29, and 49. Claims 44-45, and 47-48 are withdrawn and currently amended.

The combination of Pestotnik, Grayson, Hasegawa, and Yokoyama do not teach or suggest all of Applicant's claim limitations. There is no expectation of success in achieving all of Applicant's claim limitations by making the combination or combinations. There is no suggestion in the art to combine the references as the Office has done. Applicant submits that the rejection of dependent claims not specifically addressed, are addressed by Applicant's arguments to the claim(s) on which they depend.

Applicant respectfully submits that all claims are in condition for allowance and request such. Communication via cleartext email is authorized.

Respectfully submitted,

PELOQUIN, PLLC

November 17, 2008  
Date

Mark S. Peloquin, Esq.  
Mark S. Peloquin, Esq.  
USPTO Registration # 50,787

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